

ESTTA Tracking number: **ESTTA742496**

Filing date: **04/26/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91214449
Party	Plaintiff Omega SA (Omega AG) (Omega Ltd.)
Correspondence Address	JESS M COLLEN COLLEN IP 80 S HIGHLAND AVE OSSINING, NY 10562 UNITED STATES tgulick@collenip.com, ogelber@collenip.com, docket@collenip.com, docket@collenip.com, kmogavero@collenip.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Thomas P. Gulick
Filer's e-mail	tgulick@collenip.com, docket@collenip.com, ogelber@collenip.com
Signature	/Thomas P. Gulick/
Date	04/26/2016
Attachments	P890 P891 P893 Opposers Motion for Leave to File Amended Notices of Opposition.pdf(1213573 bytes )

**UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

OMEGA S.A. (OMEGA AG)  
(OMEGA LTD.),  
Opposer,

v.

ALPHA OMEGA EPSILON, INC.,  
Applicant.

Mark: AΩE  
Opp. No.: 91214449 (Parent)  
Serial No.: 85855823

OMEGA S.A. (OMEGA AG)  
(OMEGA LTD.),  
Opposer,

v.

ALPHA OMEGA EPSILON, INC.,  
Applicant.

Mark: ALPHA OMEGA EPSILON  
Opp. No.: 91214454 (Child)  
Serial No.: 85855839

OMEGA S.A. (OMEGA AG)  
(OMEGA LTD.),  
Opposer,

v.

ALPHA OMEGA EPSILON, INC.,  
Applicant.

Mark: ALPHA OMEGA EPSILON  
Opp. No.: 91214453 (Child)  
Serial No.: 85857065

**OPPOSER'S MOTION FOR LEAVE TO FILE  
AMENDED NOTICES OF OPPOSITION**

Pursuant to the Trademark Trial and Appeal Board's April 6, 2016 Order (Docket Entry ("D.E.") 30 in Parent Opposition No. 912114449<sup>1</sup>), Opposer hereby requests leave of the Board to amend its Notices of Opposition in the above captioned, consolidated Oppositions to clarify its dilution claims and

<sup>1</sup> It is D.E. 7 in the other consolidated oppositions. Unless otherwise noted, all Docket Entries referenced will be for the parent opposition.

to include citations to Opposer's Registration Nos. 25,036; 566,370; 578,041; 1,969,071; 3,318,408; and 4,520,281. The amendment will also make the list of pleaded registrations in each of the consolidated oppositions uniform. A copy of the proposed Amended Notice of Opposition is attached hereto as Exhibit 1.

### **FACTUAL BACKGROUND**

On February 21, 2013, Applicant filed the opposed applications to register the marks ALPHA OMEGA EPSILON (Serial No. 85855839) in connection with goods in International Class 25 "for hats, jackets, shirts, sweat pants, sweat shirts, sweaters," and AΩE (Serial No. 85855823) in International Class 14 for "jewelry[,] and in International Class 25 for "for hats, jackets, shirts, sweat pants, sweat shirts, sweaters." and the word mark in standard characters ALPHA OMEGA EPSILON (Serial No. 85857065) in connection with goods also in International Class 200, "Indicating membership in a professional and social collegiate sorority for students and alumna members." Opposer filed the appropriate Notices of Opposition on January 13, 2014. On September 8, 2014, Applicant moved for Summary Judgment.

The Trademark Trial and Appeal Board's Order (D.E. 30) denied Applicant summary judgment on Opposer's likelihood of confusion and dilution claims with respect to Opposer's claims regarding Applicant's three remaining trademark applications (Serial Nos. 85855839, 85855823, 85857065). The Board's Order granted Opposer time to serve amended dilution pleadings. In addition, the Board noted, "[i]f Opposer intends to rely on any other marks or registrations not previously pleaded, Opposer's amended notices of opposition should include these allegations and be accompanied by a motion for leave to amend under Fed. R. Civ. P. 15(a)." D.E. 30 at p. 20.

Opposer seeks to comply with the Board's Order and amend its dilution pleadings, as well as supplement its cited registrations.

### **STANDARD**

Leave to amend a pleading "must be freely given when justice so requires." Fed. R. Civ. P. 15(a)(2) ("The court should freely give leave when justice so requires.") *see also* TBMP § 507.02 (2015).

Amendments to pleadings in trademark oppositions are governed by the Federal Rules of Civil Procedure, where “[u]nder the more liberal standard of Rule 15(a), the trial court should grant leave to file absent a substantial reason for denial, such as undue delay, bad faith, dilatory motive, repeated failure to cure deficiencies with other amendments, futility of the amendment, or undue prejudice to the opposing party.” *Pressure Products Med. Supplies, Inc. v. Greatbatch Ltd.*, 599 F.3d 1308, 1309 (Fed Cir. 2010); see also *Foman v. Davis*, 371 U.S. 178, 182 (1962).

## **DISCUSSION**

Granting leave to amend the Notices of Opposition will serve the interest of justice by allowing Opposer to clarify the bases of its Oppositions, thus ensuring that the Board’s ultimate decision on the merits will be based on a record that most accurately and completely reflects the parties’ respective rights. This is precisely the purpose of the Rule: “[T]he thrust of Rule 15 is . . . that cases should be tried on their merits.” *Jet, Inc. v. Sewage Aeration Sys.*, 165 F.3d 419, 425 (6th Cir. 1999); *U.S. v. Hougham*, 364 U.S. 310, 317 (1960) (“the purpose of pleading is to facilitate a proper decision on the merits”). In addition to allowing the Board to decide the merits on a complete record, Opposer’s motion is timely made during the discovery period, and will not prejudice Applicant. Further, as the facts will demonstrate, Opposer’s motion is not futile.

### **I. APPLICANT WILL SUFFER NO PREJUDICE IF OPPOSER IS GRANTED LEAVE TO AMEND**

Of the factors before the Board on a motion for leave to amend, “the consideration of prejudice to the opposing party carries the greatest weight.” *Eminence Capital, LLC v. Aspeon, Inc.*, 316 F.3d 1048, 1052 (9th Cir. 2003); see also *Howey v. United States*, 481 F.2d 1187, 1190 (9th Cir. 1973) (“the crucial factor is the resulting prejudice to the opposing party”). Indeed, whether the amendment will prejudice the non-moving party “is the ‘touchstone of the inquiry under rule 15(a).’” *Pressure Products*, 599 F.3d at 1320.

“Timing plays a large role in the Board’s determination of whether an adverse party would be prejudiced by allowance of an amendment and as a result, long, unexplained delays may render the amendment untimely.” *TBC Brands, LLC v. Sullivan*, 2008 TTAB LEXIS 589, \*3 (TTAB Mar. 31, 2006) (citing *M. Aron Corp. v. Remington Products, Inc.* 222 U.S.P.Q. 93, 96 (TTAB 1984)). The prejudice inquiry also considers the *relative* timing of a Motion to Amend. Courts often look to the close of discovery as a reference point in determining whether granting leave to amend will result in undue prejudice. See *FDL, Inc. v. Simmons Co.*, 2003 U.S. Dist. LEXIS 24195, \*39-40 (S.D. Ind. Nov. 17, 2003) (no prejudice where discovery remained open, and distinguishing cases where leave is sought after close of discovery or final judgment). As the Board has noted, “[a]ny potential prejudice may be ameliorated by the resetting and extension of discovery and trial dates, particularly where the discovery period was still open when the motion was brought.” 99 [cents] *Only Stores v. U.S. Dream, Inc.*, Opposition No. 91116977, 2004 TTAB LEXIS 475, \*5-6 (TTAB Aug. 23, 2004) (non-precedential).

Here, Opposer is promptly moving the Board, within the time the Board expressly permitted to Opposer in its April 6, 2016 Order. See D.E. 30 at p. 20. Discovery is still open. The promptness of Opposer’s Motion is best appreciated in light of the Board’s decision in *Anheuser-Busch, Inc. v. G. Heileman Brewing Co., Inc.* In that case, the Board held that although the opposer sought leave to amend to assert a registration it obtained during proceedings – eighteen months after obtaining that registration – the passage of time was not prejudicial to the applicant. *Anheuser-Busch, Inc. v. G. Heileman Brewing Co., Inc.*, 1998 TTAB LEXIS 6, \*2-3 (TTAB Jan. 16, 1998). The Board explained that the applicant would not be prejudiced as “the proceeding is still in the discovery stage and [the applicant] will have the opportunity to assert against the registration any available defense or counterclaim.” *Id.* at \*3. Opposer is moving while discovery remains open. Applicant will likewise suffer no prejudice, as “[a]ny potential prejudice may be ameliorated by the resetting and extension of discovery and trial dates,” 99 [cents] *Only Stores*, 2004 TTAB LEXIS 475 at \*5, which extension Opposer will not contest. In reality, no such extension should be required, as the issues presented by Opposer’s proposed amendments – the dilution claim and the addition of Registrations, one of which is a previously cited application that has matured

into a registration during the pendency of these proceedings – will not require Applicant to take any additional discovery because Applicant previously had notice of Opposer’s dilution claim and Opposer has relied upon Registration Nos. 25,036; 566,370; 578,041; 1,969,071; 3,318,408; and 4,520,281 in summary judgment and Opposer previously responded to discovery requests with regard to the Registrations to be cited.

## **II. OPPOSER HAS NOT UNDULY DELAYED IN SEEKING LEAVE TO AMEND**

“[D]elay itself is an insufficient ground to deny amendment.” *Datascope Corp. v. SMEC, Inc.*, 962 F.2d 1043, 1045 (Fed. Cir. 1992). Rather, the delay must be “undue,” *Foman*, 371 U.S. at 182. The Board has held that “the concept of undue delay is inextricably linked with the concept of prejudice to the non-moving party.” *Marshall Field & Co. v. Mrs. Field’s Cookies*, 17 U.S.P.Q.2d 1652 (TTAB 1990). Courts have similarly recognized the role of prejudice in assessing whether delay has been “undue.” See *Mayeaux v. La. Health Serv. & Indem. Co.*, 376 F.3d 420, 427 (5th Cir. 2004) (“[D]elay alone is an insufficient basis for denial of leave to amend: The delay must be undue, i.e., it must prejudice the nonmoving party or impose unwarranted burdens on the court.”); *Block v. First Blood Assocs.*, 988 F.2d 344, 350 (2d Cir. 1993) (“Mere delay, however, absent a showing of bad faith or undue prejudice, does not provide a basis for a district court to deny the right to amend.”); *Edwards v. City of Goldsboro*, 178 F.3d 231, 242 (4th Cir. 1999) (“Delay alone is an insufficient reason to deny leave to amend. Rather, the delay must be accompanied by prejudice, bad faith, or futility.”).

Opposer has not unduly delayed in requesting amendment, nor will amendment prejudice Applicant. The Board’s April 6, 2016 Order sets an April 26, 2016 deadline for the service of amended dilution claims and filing of Opposer’s Motion for Leave to Amend. The instant motion seeking leave to amend is being filed within the time period specifically permitted by the Board. Opposer has acted promptly in seeking leave to amend. There is no undue delay, nor will Applicant be prejudiced by the proposed amendment.

### III. OPPOSER'S PROPOSED AMENDMENTS ARE NOT FUTILE

“‘Futility’ means that the [pleading], as amended, would fail to state a claim upon which relief could be granted.” *Glassman v. Computervision Corp.*, 90 F.3d 617, 623 (1st Cir. 1996). “[W]hether or not the moving party can actually prove the allegation(s) sought to be added to a pleading is a matter to be determined after the introduction of evidence at trial or in connection with a proper motion for summary judgment,” and should not bear on whether the Board should grant leave to amend. *See* Fed. R. Civ. P. 15(a) and TBMP § 507.02.

#### a. Registrations Cited

The Board’s Order on Summary Judgment (D.E. 30) allows Opposer time to supplement its cited registrations and demonstrates that Opposer’s effort to amend its Notices of Opposition to plead ownership of Opposer’s other registrations is not futile. The Board noted that Opposer relied upon some marks that either were not pleaded or only pleaded in select oppositions. The Board states that it considered Opposer’s registrations (Reg. Nos. 25,036; 566,370; 578,041; 1,969,071; 3,318,408; and 4,520,281) in denying Applicant’s Motion for Summary Judgment. D.E. 30 at p. 3-4, and 7. Opposer seeks to create uniformity and allege all six registrations for each of the consolidated opposition proceedings. As all six registrations factored into the Board’s denial of Applicant’s Motion for Summary Judgment in Opposition Nos. 91214449, 91214453 and 91214454, the amendment of the Notices of Oppositions to include all six registrations is not futile.

#### b. Dilution

Similarly, the Board’s denial of Summary Judgment to Applicant on the dilution claim in Opposition Nos. 91214449, 91214453 and 91214454 demonstrates that an amendment to Opposer’s dilution claim is not futile. The Board considered Opposer’s dilution claims for purposes of Applicant’s Motion for Summary Judgment, and instructed Opposer to state whether Opposer’s marks were famous before first use of Applicant’s applied-for marks. *Id.* at p. 6. The Applicant has clearly been on notice as to the Opposer’s dilution claim. Consequently, the Board’s Order specifically requires Opposer to serve

amended Notices of Oppositions for dilution claims. *Id.* at p. 20. Opposer seeks to amend its dilution claims in accordance with the Board's Order.

**IV. NO OTHER GROUNDS EXIST FOR DENYING LEAVE TO AMEND**

Opposer's Motion is not for the purposes of delay, and does not cause prejudice to Applicant. Rather, Opposer simply intends comply with the Board's April 6, 2016 Order on the Motion for Summary Judgment (D.E. 30) within the time allotted to Opposer by the Board. Accordingly, Opposer's actions are timely and are not dilatory.

Finally, Opposer's Motion is made in good faith, and if granted, will ensure that the Board's decision on the merits is made on a complete record reflecting Opposer's trademark rights.

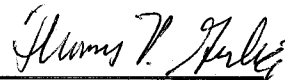
**CONCLUSION**

Because Opposer's amendment is timely, in accordance with the Board's April 6, 2016 Order, will not prejudice Applicant, and is not futile, Opposer respectfully requests that its motion be GRANTED and the attached proposed Amended Notice of Opposition be accepted as the operative pleading.

Respectfully Submitted,

Dated: April 26, 2016

By:



Jess M. Collen  
Thomas P. Gulick  
Oren Gelber  
Kristen A. Mogavero  
COLLEN IP  
The Holyoke-Manhattan Building  
80 South Highland Avenue  
Ossining, New York 10562  
Tel. (914) 941-5668  
Fax (914) 941-6091  
*Attorneys for Opposer Omega S.A.  
(Omega AG) (Omega LTD.)*

JMC/TPG/OG:cs

Encl. – Amended Notice of Opposition (and Exhibits)

SHOULD ANY OTHER FEE BE REQUIRED, THE PATENT AND TRADEMARK OFFICE IS  
HEREBY REQUESTED TO CHARGE SUCH FEE TO OUR DEPOSIT ACCOUNT 03-2465.

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING FILED  
ELECTRONICALLY WITH THE UNITED STATES PATENT AND TRADEMARK OFFICE.

Date: April 26, 2016      By: *Humu Guliel*

# EXHIBIT

1

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**TRADEMARK TRIAL AND APPEAL BOARD**

OMEGA S.A. (OMEGA AG)  
(OMEGA LTD.),

Opposer,

v.

ALPHA OMEGA EPSILON, INC.,  
Applicant.

Mark: AΩE  
Opp. No.: 91214449  
Serial No.: 85855823

**AMENDED NOTICE OF OPPOSITION**

Omega S.A. (Omega AG) (Omega Ltd.), 96 Rue Jakob Stampfli, Biel/Bienne 2502, Switzerland, a corporation duly organized and existing under the laws of Switzerland, ("Omega" or "Opposer") through their attorneys, believes that it would be damaged by the registration of the mark shown in the above-identified application, and hereby opposes same, pursuant to 15 U.S.C. § 1063 and 37 C.F.R. § 2.104.

As grounds for opposition, it is alleged that:

(1) Omega is and has been engaged in the sale and marketing of similar and highly related goods and services to those recited by Applicant in its application to register since a time prior to the date of first use alleged by Applicant in its application for registration.

(2) Omega is and has been engaged in the sale and marketing of goods under the registered trademarks  $\Omega$  and OMEGA, since at least as early as 1894.

(3) Omega is the owner of the following valid and subsisting U.S. trademark registrations, including:

OMEGA (AND DESIGN)	REG. NO.	25,036	Exhibit A
OMEGA	REG. NO.	566,370	Exhibit B
OMEGA (AND DESIGN)	REG. NO.	578,041	Exhibit C
OMEGA (AND DESIGN)	REG. NO.	1,969,071	Exhibit D
OMEGA (AND DESIGN)	REG. NO.	3,318,408	Exhibit E
OMEGA (AND DESIGN)	REG. NO.	4,520,281	Exhibit F

and others (collectively referred to as the OMEGA Marks). (See Exhibits A - F, attached)

(4) Omega has used its OMEGA Marks in commerce extensively and has acquired a considerable and valuable goodwill and wide scale recognition for its mark. The public has come to associate OMEGA and the OMEGA symbol " $\Omega$ " marks, with Opposer and Opposer's goods and services. The public has come to associate the OMEGA Marks with Opposer and Opposer's goods and services, which include not only watches and sports timing products, but clothing, accessories, and other goods and services, including retail services.

(5) Omega's application and registration are *prima facie* proof of ownership of the mark. Omega's registration is *prima facie* proof of use of the mark from the original date of filing of

the application, pursuant to 15 U.S.C 1057(b), and of the exclusive right to use the registered mark in commerce. Furthermore, Registration Numbers 25,036; 566,370; 578,041; 1,969,071 and 3,318,408 are incontestable, pursuant to section 15 of the Trademark Act.

(6) Applicant's mark is confusingly similar to Omega's registered trademarks and is likely, when applied to the goods of the Applicant, to cause confusion, or to cause mistake or to deceive. 15 U.S.C. § 1052(d). Applicant's mark makes a highly similar commercial impression to Opposer's mark due to its incorporation of an OMEGA mark, creating a virtually identical sound and appearance. Applicant has completely appropriated Opposer's entire mark. The overall commercial impression of Applicant's mark, when applied to the same or similar goods, would cause confusion or be likely to cause confusion, mistake, or deception.

(7) The Opposer has a long history of sale and offering for sale of timekeeping devices in Class 014 and related retail services. The Opposer has also used its mark in a variety of ways in sponsorships and in areas such as sports timing in a highly visible way, including but not limited to as an official sponsor and official timekeeper for the Olympic Games in Beijing, China in 2008, Vancouver, Canada in 2010, London, England in 2012, Sochi, Russia in 2014, the upcoming 2016 Olympic Games to be held in Rio de Janeiro, Brazil, as well as other professional and amateur contests. Opposer is in the field of advertising and marketing its goods and involved in sponsorships and endorsement, which form a major component of the Opposer's brand marketing efforts in the U.S. and abroad.

(8) Omega has used its OMEGA Marks in commerce extensively and has acquired a considerable and valuable goodwill and wide scale recognition for its mark. The public has come to associate the OMEGA Marks with Opposer and Opposer's goods and services. The public has come to associate the OMEGA marks with Opposer and Opposer's

timepieces, jewelry, sports timing products, clothing, accessories, retail services and sports promotion.

(9) On information and belief, use by the Applicant will cause confusion, mistake and deception with respect to those goods and services, by virtue of the Opposer's prior use and fame of its OMEGA mark.

(10) On information and belief, both the Applicant's mark and the OMEGA Marks are applied to highly related goods and services are likely to be sold to the same or similar channels of distribution. Applicant's mark so resembles Omega's OMEGA registrations and well-known trademarks, as used in the United States and not abandoned, as to be likely to cause confusion, or to cause mistake or to deceive.

(11) In addition, even use of the OMEGA symbol "Ω" mark with additional symbols, as depicted in Applicant's application, is highly similar to the manner in which the Opposer uses its marks.

(12) Upon information and belief, Applicant's actions would substantially harm the Opposer, by permitting registration in favor of Applicant for a mark which the Opposer used on its goods from an earlier date.

(13) Opposer's OMEGA mark is a famous mark in the United States.

(14) Upon information and belief, Opposer's OMEGA mark was famous prior to established, continuous use of Applicant's mark.

(15) Applicant's mark dilutes or is likely to dilute the distinctive character of the Opposer's mark.

OPPOSER Omega prays that this application Serial No. 85855823, be refused, that no registration be issued thereon to Applicant and that this Opposition be sustained in favor of Omega.

Respectfully submitted for  
Opposer, OMEGA S.A.

By: Thomas P. Gulick

Jess M. Collen  
Thomas P. Gulick  
Oren Gelber  
COLLEN *IP*  
The Holyoke-Manhattan Building  
80 South Highland Ave  
Ossining, NY 10562  
(914) 941-5668  
(914) 941-6091

DATED: April 26, 2016  
Encls.: Exhibits A-F

SHOULD ANY OTHER FEE BE REQUIRED, THE PATENT AND TRADEMARK OFFICE IS HEREBY REQUESTED TO CHARGE SUCH FEE TO OUR DEPOSIT ACCOUNT 03-2465.

I HEREBY CERTIFY THAT THIS NOTICE OF OPPOSITION IS BEING FILED ELECTRONICALLY WITH THE UNITED STATE PATENT AND TRADEMARK OFFICE.

COLLEN *IP*, THE HOLYOKE-MANHATTAN BUILDING, 80 SOUTH HIGHLAND AVENUE, OSSINING, NEW YORK 10562

By: Thomas P. Gulick

Date: April 26, 2016

EXHIBIT

A

original

Renewed to  
Societe Anonyme Louis Brandt & Frere Omega Watch Co.  
Renewed July 24-1944 to Societe Anonyme Louis Brandt  
& Frere Omega Watch Co., an organized company of  
Switzerland.

## UNITED STATES PATENT OFFICE.

LOUIS BRANDT & FRÈRE, OF BIENNE, SWITZERLAND.

### TRADE-MARK FOR WATCH-MOVEMENTS AND WATCHCASES.

STATEMENT and DECLARATION of Trade-Mark No. 25,036, registered July 24, 1894.

Application filed May 23, 1894.

#### STATEMENT.

*To all whom it may concern:*

Be it known that we, LOUIS BRANDT & FRÈRE, a firm domiciled and doing business in Bienne, Switzerland, have adopted for our use a Trade-Mark for Watch-Movements and Watchcases, of which the following is a full, clear, and exact specification.

Our trade-mark consists of the arbitrary sign of the last letter of the Greek alphabet. This has generally been arranged as shown in the accompanying fac-simile, in which it appears above the word "Omega." But it may be differently arranged and the word "Omega" may be omitted without materially altering the character of our trade-mark, the essential feature of which is the Greek letter "Ω."

This trade-mark has been continuously used by us in our business since March 10, 1894.

The class of merchandise to which this trade-mark is appropriated is horology, and the particular description of goods comprised in such class on which it is used by us is watch-movements and watch-cases. It is usually affixed to the goods by stamping or by printing it upon suitable labels which are afterward placed upon the packages containing the articles.

Signed this 2d day of May, 1894.

LOUIS BRANDT & FRÈRE.

Witnesses:

EDOUARD HAAS,  
ALF. H. BESSIER.

#### DECLARATION.

United States consulate Berne Switzerland ss.

LOUIS PAUL BRANDT being duly sworn deposes and says that he is a member of the firm of LOUIS BRANDT AND FRÈRE, the applicants named in the foregoing statement; that he verily believes that the foregoing statement is true; that the said firm has at this time a right to the use of the trade-mark therein described; that no other person, firm or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that it is

used by the applicants in commerce between the United States and foreign nations and particularly with Switzerland; and that the description and fac-simile presented for record truly represent the trade-mark sought to be registered.

LOUIS PAUL BRANDT.

Sworn to and subscribed before me this 14th day of June, 1894.

[L. S.]

JOHN E. HINNEN,  
U. S. Vice-Consul.

Republished, under the Act of 1946, Jan. 17, 1950, by  
Omega Louis Brandt & Frere, S. A., Bienne, Switzerland.

New Certificate issued November 18, 1952, under Sec. 7c for unexpired term to Omega Louis Brandt & Frere S. A., of Bienne, Switzerland, a corporation of Switzerland, by change of name from Societe Anonyme Louis Brandt & Frere Omega Watch Co.



Assignments on the Web > [Trademark Query](#)

## Trademark Assignment Abstract of Title

**Total Assignments: 2**

**Serial #:** 70025036

**Filing Dt:** 05/23/1894

**Reg #:** 25036

**Reg. Dt:** 07/24/1894

**Registrant:** LOUIS BRANDT & FRERE

**Mark:** OMEGA

**Assignment: 1**

**Reel/Frame:** 0440/0955

**Recorded:** 05/20/1983

**Pages:** 0

**Conveyance:** CHANGE OF NAME 19820324

**Assignors:** TIPP-EX FABRIKATION WOLFGANG DABISCH CHANGED TO

TIPP-EX TECHNIK WOLFGANG DABISCH CHANGED TO

**Assignee:** WOLFGANG DABISCH

**Correspondent:** HENRY L. SHENIER  
380 LEXINGTON AVE.  
NEW YORK, NY 10168

**Exec Dt:** 03/24/1982

**Entity Type:** UNKNOWN

**Citizenship:** NONE

**Exec Dt:** 00/00/0000

**Entity Type:** UNKNOWN

**Citizenship:** NONE

**Entity Type:** UNKNOWN

**Citizenship:** NONE

**Assignment: 2**

**Reel/Frame:** 0444/0955

**Recorded:** 05/05/1983

**Pages:** 3

**Conveyance:** CHANGE OF NAME 19820624

**Assignor:** OMEGA LOUIS BRANDT & FRERE S.A.

**Assignee:** OMEGA SA (OMEGA AG) (OMEGA LTD.)

**Correspondent:** HENRY L. SHENIER  
SHENIER & O'CONNOR  
380 LEXINGTON AVE.  
NEW YORK, NY 10168  
SHENIER AND O'CONNOR

**Exec Dt:** 03/16/1983

**Entity Type:** UNKNOWN

**Citizenship:** NONE

**Entity Type:** UNKNOWN

**Citizenship:** NONE

# EXHIBIT B

Registered Nov. 4, 1952.

Registration No. 566,370

**PRINCIPAL REGISTER**  
**Trade-Mark**

**UNITED STATES PATENT OFFICE**

Omega Louis Brandt & Frère, S. A.,  
Bienne, Switzerland

Act of 1946

Application December 8, 1951, Serial No. 622,275

**OMEGA**

**STATEMENT**

Omega Louis Brandt & Frère, S. A., a Swiss corporation, located and doing business at Bienne, Switzerland, has adopted and is using the trade-mark shown in the accompanying drawing, for WATCHES AND PARTS THEREOF, in Class 27, Horological instruments, and presents herewith five specimens showing the trade-mark as actually used in connection with such goods, the trade-mark being applied by stamping, printing or engraving the same on the goods and by printing the same on the containers and/or tags attached to the goods, and requests that the same be registered in the United States Patent Office on the Principal Register in accordance with the act of July 5, 1946.

The trade-mark was first used in 1894 and was first used in commerce which may lawfully be regulated by the Congress, viz. commerce between the United States and Switzerland in the same year.

Applicant owns the following U. S. registration: No. 25,036.

The applicant hereby designates Chauncey P. Carter, of 4400 Klingie Street, Washington 16, D. C., as applicant's representative in the United States on whom notices or process in proceedings affecting the mark may be served.

OMEGA LOUIS BRANDT & FRÈRE, S. A.,  
By A. VALLAT,  
Commercial Manager.

COMB. ACT. SEC. 8 & 15

DEC 23 1957



**Assignments on the Web > Trademark Query**

**Trademark Assignment Abstract of Title**

**Total Assignments: 1**

**Serial #:** 71622275

**Filing Dt:** 12/08/1951

**Reg #:** 566370

**Reg. Dt:** 11/04/1952

**Registrant:** OMEGA LOUIS BRANDT & FRERE, S.A.

**Mark:** OMEGA

**Assignment: 1**

**Reel/Frame:** 0582/0575

**Recorded:** 11/13/1987

**Pages:** 3

**Conveyance:** CHANGE OF NAME 19820624

**Assignor:** OMEGA LOUIS BRANDT & FRERE S.A.

**Exec Dt:** 04/15/1987

**Entity Type:** UNKNOWN

**Citizenship:** NONE

**Entity Type:** UNKNOWN

**Citizenship:** NONE

**Assignee:** OMEGA SA (OMEGA AG) (OMEGA LTD.)

**Correspondent:** SHENIER & O'CONNOR  
122 EAST 42ND STREET  
NEW YORK, NY 10168

Search Results as of: 04/20/2016 03:37 PM  
If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350. v2.5  
Web interface last modified: July 25, 2014 v2.5

# EXHIBIT C

Int. Cl.: 14

Prior U.S. Cl.: 27

United States Patent and Trademark Office  
10 Year Renewal

Reg. No. 578,041

Registered July 28, 1953

Renewal Term Begins July 28, 1993

**TRADEMARK  
PRINCIPAL REGISTER**



OMEGA SA (OMEGA AG) (OMEGA LTD.) (SWITZERLAND CORPORATION)  
BIENNE, SWITZERLAND, BY CHANGE OF NAME FROM OMEGA LOUIS BRANDT & FRERE, S.A. (SWITZERLAND CORPORATION) BIENNE, SWITZERLAND

OWNER OF U.S. REG. NOS. 25,036 AND 566,370.

FOR: WATCHES (INCLUDING POCKET WATCHES, WRIST WATCHES

WITH OR WITHOUT STRAPS, BANDS OR BRACELETS, PENDANT WATCHES, CALENDAR WATCHES, AND STOP-WATCHES) EITHER STEM-WIND OR AUTOMATIC; CLOCKS; CHRONOMETERS, CHRONOGRAPHS, AND PARTS FOR ALL OF THE FOREGOING, IN CLASS 27 (INT. CL. 14).

FIRST USE 0-0-1894; IN COMMERCE 0-0-1894.

SER. NO. 71-637,074, FILED 10-23-1952.

*In testimony whereof I have hereunto set my hand  
and caused the seal of The Patent and Trademark  
Office to be affixed on June 21, 1994.*

COMMISSIONER OF PATENTS AND TRADEMARKS

Registered July 28, 1953

Registration No. 578,041

**PRINCIPAL REGISTER**  
**Trade-Mark**

**UNITED STATES PATENT OFFICE**

Omega Louis Brandt & Frère, S. A.,  
Bienne, Switzerland

Act of 1946

Application October 23, 1952, Serial No. 637,074



**STATEMENT**

Omega Louis Brandt & Frère, S. A., a Swiss corporation, located and doing business at Bienne, Switzerland, has adopted and is using the trade-mark shown in the accompanying drawing, for WATCHES (INCLUDING POCKET WATCHES, WRIST WATCHES WITH OR WITHOUT STRAPS, BANDS OR BRACELETS, PENDANT WATCHES, CALENDAR WATCHES, AND STOPWATCHES) EITHER STEM-WIND OR AUTOMATIC; CLOCKS; CHRONOMETERS, CHRONOGRAPHS, AND PARTS FOR ALL OF THE FOREGOING, in Class 27, Horological instruments, and presents herewith five specimens showing the trade-mark as actually used in connection with such goods, the trade-mark being applied to the goods; to tags or labels fastened to the goods; or to the containers, and requests that the same be registered in the United States

Patent Office on the Principal Register in accordance with the act of July 5, 1946.

The trade-mark was first used in 1894, and was first used in commerce which may lawfully be regulated by Congress, viz., commerce between the United States and Switzerland in the same year. Such first usage was on watches.

Applicant owns the following U. S. registrations: Nos. 25,036 and 566,370.

The applicant hereby designates Chauncey P. Carter, of 4400 Klinge Street, Washington 16, D. C., as applicant's representative in the United States on whom notices or process in proceedings affecting the mark may be served.

OMEGA LOUIS BRANDT &  
FRÈRE, S. A.,

By ADOLPHE VALLAT,  
Commercial Manager.

COMB. AFF. SEC. 8 & 15

FEB 2 - 1959



Assignments on the Web > Trademark Query

**Trademark Assignment Abstract of Title**

**Total Assignments: 1**

**Serial #:** 71637074

**Filing Dt:** 10/23/1952

**Reg #:** 578041

**Reg. Dt:** 07/28/1953

**Registrant:** OMEGA LOUIS BRANDT & FRERE, S.A.

**Mark:** OMEGA

**Assignment: 1**

**Reel/Frame:** 1135/0407

**Recorded:** 04/12/1994

**Pages:** 5

**Conveyance:** CHANGE OF NAME EFFECTIVE 6-24-82.

**Assignor:** OMEGA LOUIS BRANDT & FRERE S.A.

**Exec Dt:** 04/15/1987

**Entity Type:** CORPORATION

**Citizenship:** SWITZERLAND

**Assignee:** OMEGA SA (OMEGA AG) (OMEGA LTD.)

BIENNE, SWITZERLAND

**Entity Type:** CORPORATION

**Citizenship:** SWITZERLAND

**Correspondent:** JESS M. COLLEN

MCGLEW AND TUTTLE, P.C.

SCARBOROUGH STATION

SCARBOROUGH, NY 10510-0827

Search Results as of: 04/20/2016 03:37 PM  
If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350. v.2.5  
Web interface last modified: July 25, 2014 v.2.5

# EXHIBIT D

Int. Cls.: 6, 16, 18, 25 and 30

Prior U.S. Cls.: 13, 25, 37, 39, 41 and 46

Reg. No. 1,969,071

**United States Patent and Trademark Office** Registered Apr. 23, 1996

**TRADEMARK  
PRINCIPAL REGISTER**



OMEGA S.A. (OMEGA AG) (OMEGA LTD.)  
(SWITZERLAND CORPORATION)  
96, RUE STAEMPFLI  
BIENNE, SWITZERLAND

FOR: METAL KEY RINGS, IN CLASS 6 (U.S. CLS. 13 AND 25).

FOR: PENS AND PENCILS; NAMELY, MECHANICAL PENCILS AND BALL POINT AND FELT-TIP PENS, IN CLASS 16 (U.S. CL. 37).

FOR: UMBRELLAS AND PARASOLS, IN CLASS 18 (U.S. CL. 41).

FOR: CLOTHING; NAMELY, SCARVES, AND NECKTIES, IN CLASS 25 (U.S. CL. 39).

FOR: CHOCOLATES, IN CLASS 30 (U.S. CL. 46).

OWNER OF SWITZERLAND REG. NO. 368846, DATED 12-16-1988, EXPIRES 12-16-2008.

OWNER OF U.S. REG. NO. 1,290,661.

SER. NO. 74-355,965, FILED 2-5-1993.

JYLL A. SMITH, EXAMINING ATTORNEY



United States Patent and Trademark Office

[Home](#) | [Site Index](#) | [Search](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)



[Assignments on the Web](#) > [Trademark Query](#)

**No assignment has been recorded at the USPTO**

**For Registration Number: 1969071**

If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350, v.2.5  
Web interface last modified: July 25, 2014 v.2.5

| [HOME](#) | [INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [CONTACT US](#) | [PRIVACY STATEMENT](#)

# EXHIBIT

## E

Int. Cl.: 41

Prior U.S. Cls.: 100, 101 and 107

United States Patent and Trademark Office

Reg. No. 3,318,408

Registered Oct. 23, 2007

SERVICE MARK  
PRINCIPAL REGISTER



OMEGA SA (OMEGA AG) (OMEGA LTD.) (SWITZERLAND JOINT STOCK COMPANY)  
JAKOB-STÄMPFLI-STRASSE 96  
CH-2502 BIEL/BIENNE  
SWITZERLAND

PRIORITY DATE OF 8-24-2005 IS CLAIMED.

OWNER OF INTERNATIONAL REGISTRATION  
0865357 DATED 9-29-2005, EXPIRES 9-29-2015.

FOR: TIMEKEEPING OF SPORTS EVENTS; ORGANIZATION OF SPORTS AND CULTURAL EVENTS NAMELY ORGANIZATION OF WATER SPORTS, ATHLETIC, GOLF, SAILING AND TENNIS COMPETITIONS AND ORGANIZATION OF ART EXHIBITS AND OF CINEMATOGRAPHIC, MUSICAL AND THEATRICAL PERFORMANCES, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

OWNER OF U.S. REG. NOS. 578,041, 3,063,837 AND OTHERS.

SER. NO. 79-016,420, FILED 9-29-2005.

STEVEN PEREZ, EXAMINING ATTORNEY



United States Patent and Trademark Office

[Home](#) | [Site Index](#) | [Search](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)



**Assignments on the Web > Trademark Query**

**No assignment has been recorded at the USPTO**

**For Registration Number: 3318408**

If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350. v.2.5  
Web interface last modified: July 25, 2014 v.2.5

[| .HOME](#) | [| INDEX](#) | [| SEARCH](#) | [| eBUSINESS](#) | [| CONTACT US](#) | [| PRIVACY STATEMENT](#)

# EXHIBIT

# F

**United States of America**  
United States Patent and Trademark Office

**Ω**  
**OMEGA**

**Reg. No. 4,520,281**

**Registered Apr. 29, 2014**

**Int. Cl.: 35**

**SERVICE MARK**

**PRINCIPAL REGISTER**

OMEGA SA (OMEGA AG)(OMEGA LTD.) (SWITZERLAND CORPORATION)  
JAKOB-STAMPFLI-STRASSE 96  
2502 BIEL/BIENNE, SWITZERLAND

FOR: RETAIL STORE SERVICES FEATURING PERFUMERY, JEWELLERY, HOROLOGICAL  
AND CHRONOMETRIC INSTRUMENTS, FINE LEATHER GOODS, IN CLASS 35 (U.S. CLS.  
100, 101 AND 102).

FIRST USE 12-5-2000; IN COMMERCE 3-23-2006.

OWNER OF SWITZERLAND REG. NO. 532344, DATED 4-7-2005, EXPIRES 2-9-2015.

OWNER OF U.S. REG. NOS. 25,036, 3,831,079 AND OTHERS.

THE MARK CONSISTS OF THE OMEGA LETTER OF THE GREEK ALPHABET ABOVE  
THE WORD "OMEGA".

SER. NO. 85-877,912, FILED 3-15-2013.

TINA MAI, EXAMINING ATTORNEY



*Michelle K. Lee*

Deputy Director of the United States  
Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL  
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE  
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

**Requirements in the First Ten Years\***

**What and When to File:**

**First Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. *See* 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

**Second Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.\*  
*See* 15 U.S.C. §1059.

**Requirements in Successive Ten-Year Periods\***

**What and When to File:**

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.\*

**Grace Period Filings\***

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or  
reminder of these filing requirements.**

**\*ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the USPTO. The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. *See* 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. *See* 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

**NOTE:** Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.



United States Patent and Trademark Office

[Home](#) | [Site Index](#) | [Search](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)



**Assignments on the Web > Trademark Query**

**No assignment has been recorded at the USPTO**

**For Registration Number: 4520281**

If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350. v2.5  
Web interface last modified: July 25, 2014 v2.5

[HOME](#) | [INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [CONTACT US](#) | [PRIVACY STATEMENT](#)

**CERTIFICATE OF SERVICE**

I, Carina Scorcio, hereby certify I caused a true copy of the foregoing Opposer's Motion for Leave to Amend Notices of Opposition to be served upon:

McBrayer, McGinnis, Leslie & Kirkland, PLLC  
9300 Shelbyville Road, Suite 110  
Louisville, KY 40222

By first class mail, postage pre-paid on this 26th Day of April, 2016. With a courtesy copy sent to: jwheat@mmlk.com.

Carina Scorcio